



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,067	10/12/2000	Kenneth A. Berger	014600/0002	8168

20594 7590 09/22/2004

CHRISTOPHER J. ROURK
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
P O BOX 688
DALLAS, TX 75313-0688

EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/689,067	BERGER ET AL.	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	<i>WJ</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 5/28/04 has been entered.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Method claims 19-21, 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 19-21, 10-18 are directed to "A method for performing enterprise resource management (ERP)", which is not within one of the classes of invention set forth in § 101.

The "method for performing ERP" comprising the steps of:

- (a) receiving field data,
- (b) initializing and executing one or more helpers, and
- (c) storing the field data using one or more helpers", as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "method for performing ERP" comprising the steps of (a)-(c) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (integration of computer/global network computer in the body of the

Art Unit: 3629

claim) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 112

3. Claims 1-9 (Apparatus¹), 10-18 (Method¹), 19-21 (Method²) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: it's not clear the relationship between "a plurality of computer-implemented systems" to the rest of the claims, especially helper systems. It's not clear how the amended limitation of "a plurality of computer-implemented systems" is used to carry out the enterprise resource management. The amended phrase "wherein one or more ...in response to the data received from the process thread processes" is vague and indefinite. It's not clear how all of these elements are carried out to achieve the scope of the claim which is a system for enterprise resource management.

5. Method claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite.

Art Unit: 3629

1) It's not clear the relationship of the amended language "using a plurality of helpers ...thread processes" to the body of the claim or steps: (a) receiving order data, ... (e) processing the order.

2) The amended phrase "using a plurality of helpers ...in response to the data received from the process thread processes" is vague and indefinite.

3) The phrase "obtain data from one or more process thread processes" is vague and indefinite.

4) It's not clear how all of these steps are carried out to achieve the scope of the claim which is method for performing enterprise resource management. It's not clear the relationship between "a computer-implemented method that further comprising" to the rest of the claims, especially helper systems. Applicant is requested to put the amended language in the body of the claim and not in the preamble in order to receive much patentable weight on the claim.

6. Method claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite.

1) It's not clear the relationship of the amended language "using a plurality of helpers ...thread processes" to the body of the claim or steps: (a) receiving order data, ... (d) storing the field data using the one or more helpers".

2) The amended phrase "using a plurality of helpers ...in response to the data received from the process thread processes" is vague and indefinite.

3) The phrase "obtain data from one or more process thread processes" is vague and indefinite.

Art Unit: 3629

4) It's not clear how all of these steps are carried out to achieve the scope of the claim which is method for performing enterprise resource management. It's not clear the relationship between "a computer-implemented method that further comprising" to the rest of the claims, especially helper systems. Applicant is requested to put the amended language in the body of the claim and not in the preamble in order to receive much patentable weight on the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 19-21, 10-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DU et al (US 6,308,163).**

As for claims 19-20, 10-11, DU et al disclose a method for performing enterprise resource management (ERP) comprising:

Art Unit: 3629

(a) receiving field data,

(b) initializing and executing one or more helpers, and

(c) storing the field data using one or more helpers (Figs. 2, 6, 7, col. 4, line 35-55, col. 10, line 45 to col. 11, line 35). The use of any other enterprise field data or business task would have been obvious in view of the teachings on cols. 1-2.

As for dep. claim 21 (part of 19), this is shown on Fig. 7 or col. 10-11.

As for dep. claims 13-14 (part of 10), these are taught on col. 10, line 65 to col. 11, line 30.

As for dep. claims 15-16 (part of 10), this is taught in Fig. 7.

As for dep. claims 17-18 (part of 10), DU et al discloses other areas of business tasks such as financial issues such as payment, payroll, etc., therefore, dealing with other financial issues such as generating general ledger, financial numbers, etc., would have been obvious (see col. 3 line 65 to col. 4, line 15).

10. Claims 1-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over ARTICLE 1998 ("A Flexible architecturesoftware maintenance).

As for indep. claim 1, ARTICLE 1998 discloses a system comprising the elements as shown in claim 1 (see abstract). The use of any other enterprise field data or business task would have been obvious in view of the teachings on the abstract.

As for dep. claims 2-9 (part of 1), these are inherently included in the general teachings of ARTICLE 1998.

Art Unit: 3629

11. Claims 1-9 are rejected (2nd) under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KLATT et al (US 6,415,277).

As for indep. claim 1, KLATT et al discloses a system comprising the elements as shown in claim 1 (see Figs. 2, 12, 13, col. 4, lines 1-15, col. 6, lines 12-17, col. 9, lines 10-20). The use of any other enterprise field data or business task would have been obvious in view of the teachings on col. 5, lines 5-12, col. 6, lines 12-17.

As for dep. claims 2-3, 7, these are shown on Fig. 12.

As for dep. claim 4, this is shown on col. 7, lines 32-42, 45-60.

As for dep. claims 5-6, these are shown on Fig. 13.

As for dep. claim 8, this is shown in col. 6, lines 12-22, 60-67.

As for dep. claim 9, this is shown on col. 1, lines 30-45, col. 2, lines 35-42, col. 4, lines 5-15.

Response to Arguments

12. Applicant's arguments filed 5/28/2004 have been fully considered but they are not persuasive.

Applicant's argument with respect to the 101 rejections of method claims 10-18 and 19-21 in view of the amendment is noted, but these are not found persuasive because merely adding "a computer-implemented method" in the preamble of the claim is insufficient to overcome the rejections. Applicant needs to revise the claims to integrate the computer system into the body or steps of the claimed invention or how the steps are carried out using the computer network system.

Art Unit: 3629

Applicant's argument with respect to the 102/103 rejections of method claims 10-18 and 19-21 and apparatus claims 1-9 in view of the amendment is noted, but these are not found persuasive because of the 112, 2nd issues caused by the amended language and the amendments are mostly in the preamble of the claims and not in the body of the claims and therefore receive very little patentable weight.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

No claims are allowed.

Art Unit: 3629

14. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113 or <http://pair-direct@uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
September 20, 2004


DEAN T. NGUYEN
PRIMARY EXAMINER